

### **Listing of Claims:**

This listing of claims will replace all prior versions, and listing, of claims in the application:

Claims 1-19 (canceled).

20. (original): An ophthalmic lens comprising an optically transparent substrate, wherein the substrate is coated, on at least one face, with an optically transparent impregnatable thin film, adhering to the substrate and comprising an impregnation composition.
21. (original): The ophthalmic lens of claim 20, wherein the impregnatable thin film is produced from a polymer material, preferably obtained from a latex.
22. (original): The ophthalmic lens of claim 21, wherein the impregnatable film is produced from a polymer material obtained from a polyurethane latex.
23. (original): The ophthalmic lens of claim 20, wherein the impregnation composition is a solution or dispersion, in a diluent medium, of the additive to be incorporated.
24. (original): The ophthalmic lens of claim 20, wherein the impregnation composition contains an agent for retaining the additive, preferably a crosslinking agent.
25. (original): The ophthalmic lens of claim 20, wherein the additive incorporated in the impregnatable film is a dye.
26. (original): The ophthalmic lens of claim 25, wherein the impregnatable film in which the additive is incorporated is coated with an anti-scratch coating, preferably based on a silane hydrolysate.

## **A Response to the Office Action:**

### **A. Status of the Claims**

Claims 20-26 were pending at the time the Office Action dated June 10, 2004 was issued from the U.S. Patent Office. No claims have been amended, added, or canceled. Claims 20-26 therefore are currently pending.

### **B. The Indefiniteness Rejection is Improper**

The Action rejects claims 20-26 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Action contends that the phrase “and comprising an impregnation composition” is vague and indefinite, as that phrase is used claim 20.

Applicants traverse. Claims 20-26 are definite and satisfy all of the requirements under 35 U.S.C. 112, second paragraph.

It is well settled that “[t]he test for definiteness under 35 U.S.C. § 112, second paragraph is whether those skilled in the art would understand what is claimed when read in light of the specification.” *See* MPEP § 2173.02 (citations and internal quotations omitted); *see also Miles Lab., Inc. v. Shandon Inc.*, 997 F.2d 870, 875 (Fed. Cir. 1993) (“If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, [section] 112 demands no more”).

The phrase “and comprising an impregnation composition” is definite. This phrase is described and explained in non-limiting embodiments in Applicants’ specification. *See, e.g.*, the Specification, page 4, line 27, to page 5, line 22. In a non-limiting passage, for example, the specification states:

The impregnation composition according to the invention is a composition which contains at least one additive to be incorporated in an appropriate diluent medium.

*Id.* at page 4, lines 27-29. A person of ordinary skill in the art would understand the phrase “and comprising an impregnation composition” by reading the specification. This is further supported by additional non-limiting passages in the specification. *See id.*, at page 4, line 30, to page 5, line 22. The requirements of 35 U.S.C. § 112, second paragraph, “demand no more.” *See Miles Lab*, 997 F.2d at 875; *see also* MPEP § 2173 (noting that “[t]he primary purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent”).

The rejection of claims 20-26 under 35 U.S.C. § 112, second paragraph, is improper and should be withdrawn.

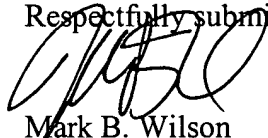
### **C. Conclusion**

Applicants believe that the present document is a full and complete response to the Office Action dated June 10, 2004. The present claims are in a condition for allowance, and such favorable action is requested.

It is believed that no fee is due for filing this paper. Should any fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to this document, consider this paragraph such a request and authorization to withdraw the appropriate fee from Fulbright & Jaworski Deposit Account No. 50-1212/ESSR:060USD1.

The Examiner is invited to contact the undersigned Attorney at (512) 536-3035 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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